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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,446	06/05/2001	Davin J. Fifield	43576.830012.US1	5057

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EXAMINER

SAIN, GAUTAM

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/875,446	FIFIELD ET AL.	
	Examiner	Art Unit	
	Gautam Sain	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- 1) This is a Final rejection in response to arguments filed on March 22, 2006.
- 2) Claims 1-20 are pending and rejected in this action.
- 3) Effective date is 5/5/2000.

Claim Rejections - 35 USC § 103

- 4) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4-1) Claim 1, 3-6, 7- 9, 11-15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smithies et al (US 6091835, filed Feb 1998), in view of Kocher (US 6901509, filed Feb 2000).

Regarding claim 1, 7, 8, 9, 17 and 19, Smithies teaches *performing a first hash operation on the electronic transcript to generate a representation of the contents of the electronic transcript*. Smithies discloses a method for transcribing electronic affirmations (Title), where the hash encoding is equal to "document checksum" (col 14, lines 14-17), and a checksum is created of the document transcript object (col 8, lines 25-38).

Smithies teaches *concatenating data to the representation of the contents of the electronic transcript, said data identifying a user; digitally signing the notary record*. Smithies discloses a digital signature that is added to the principal transcript object after verification by the transcript generator (col 9, lines 40-44).

Smithies teaches *providing for the recording and time stamping by a digital notary service of the representation of the contents of the electronic transcript and the data; obtaining a notary record from the digital notary service of the time stamping.*

Smithies discloses including the affirming party's input in verifying the time stamp data as evidence that the affirming party validly affirmed the document (col 13, line 30 – col 14, line 4).

Smithies teaches *forming an electronically signed electronic transcript by bundling the digitally signed notary record with the electronic transcript and with the data identifying the user.* For example, Smithies discloses a system that adds the signature information to the principal transcript to (col 9, lines 40-45) and creates a resulting transcript with a private key that verifies the identity of a party, including an affirmation (col 8, lines 1-15).

Smithies does not expressly teach, but Kocher teaches *performing a second hash operation on the data concatenated to the representation, the second hash operation generating a representation of the contents of the electronic transcript and the data.* Kocher discloses a method for demonstrating and confirming the status of a digital certificate and other data (Title), where hashing the result of the previous hash suggests that a second hash is performed on the results of the first hash operation (col 10, lines 15-25).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Smithies to include hashing the result of the previous hash suggests that a second hash is performed on the results of the first hash operation as taught by

Kocher, providing the benefit of demonstrating and confirming the status of a digital certificates and other data on a computer-implemented method (Kocher, Abstract section) and calling the transcript generator module to affirm a previously saved transcript object (Smithies, col 12, lines 40-42).

Regarding claim 3, 11, Smithies teaches data includes a user name uniquely identifying the user (ie., affirming party, identifying party entering affirming data, password)(col 7, lines 23-30).

Regarding claim 4, 12, Smithies teaches data includes a user number associated with the user (ie., ... unique secret number ...)(col 7, lines 45-50).

Regarding claim 5, 13, Smithies teaches data includes a recipient's name (ie., ... party's name)(col 7, lines 50-52).

Regarding claim 6, 14, Smithies teaches data includes a unique identifier which uniquely identifies the transcript. Smithies teaches encoding a document or transaction with information that verifies the integrity of the document (col 14, lines 5-21) and identification data by system that transcript generator collects (col 13, lines 52-60).

Regarding claim 15, Smithies teaches " file contains ... transcript" (ie., transcript object can be encrypted in a statement file)(col 8, lines 25-30).

Art Unit: 2176

4-2) Claims 2, 10, 16, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smithies et al (as cited above), in view of Kocher (as cited above), further in view of Blake-Wilson et al (US 6336188, filed May 1998).

Regarding claim 2, 10, Smithies in view of Kocher does not teach, but Blake-Wilson teaches "has operation is a RIPEMD-160 hash operation" (ie., hash function, RIPEMD-160)(col 5, lines 25-40).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Smithies in view of Kocher to include RIPEMD hashing as taught by Blake-Wilson, providing the benefit of authentication key agreement protocols used in digital data communication systems (Blake-Wilson, col 1, lines 4-5, lines 60-65).

Regarding claims 16, 18, 20, Smithies teaches "file excludes page numbers, line numbers, headers, and footers" (ie., the transcript file does not indicate the presence of page numbers, line numbers, headers or footers)(Summary section). Additionally, has been very common to one of ordinary skill in the art at the time of the invention to use word processor software applications (ie., Microsoft Word,... etc) that allow for toggling page number, line numbers, headers and footers off and on depending on the user's choice.

Response to Arguments

Applicant's arguments filed 3/22/06 have been fully considered but they are not persuasive.

*Regarding independent claim 1, Applicant argues that the prior art (Smithies in view of Kocher) **does not teach the claimed limitations of concatenating data to the representation of the contents of the electronic transcript, said data identified by the user and performing a second hash operation on the data concatenated to the representation*** (Remarks, page 3-5). The Examiner disagrees, Smithies discloses a digital signature that is added to the principal transcript object after verification by the transcript generator (col 9, lines 40-44). The Examiner equates Smithies disclosure of adding the additional information to the transcript object as equivalent to concatenating data to the electronic transcript because adding data means including more data to the existing data, which is the same as concatenating. The Smithies system allows addition of different data at different time and by different people in order to avoid forgery and collusion among one or more parties (col 9, lines 50-55).

Applicant argues (on page 4, top) that Smithies (nor Kocher) teaches:

- providing for the recording and time stamping by a digital notary service of the representation of the contents of the electronic transcript and the data; obtaining a notary record from a digital notary service of the time stamping.

The Examiner disagrees because Smithies discloses including the affirming party's input in verifying the time stamp data as evidence that the affirming party validly affirmed the document (col 13, line 30 – col 14, line 4). The user can be anyone,

including a notary. The Smithies system allows different users provide information towards completing an electronic transcript including the affirming party in order to avoid forgery and collusion among one or more parties (col 9, lines 50-55).

- *digitally signing the notary record.* The Examiner disagrees because Smithies discloses a digital signature that is added to the principal transcript object after verification by the transcript generator (col 9, lines 40-44).

- *forming an electronically signed electronic transcript by bundling the digitally signed notary record with the electronic transcript and with the data identifying the user.* The Examiner disagrees because Smithies adds the signature information to the principal transcript to (col 9, lines 40-45) and creates a resulting transcript with a private key that verifies the identity of a party, including an affirmation (col 8, lines 1-15).

At the bottom of page 4 of the Remarks, The Applicant points out deficiencies of the previous office action by the Examiner. In response, the Examiner has clarified the rejection using Smithies and Kocher to better reflect how the combination of references when viewed in their entirety, do teach or suggest the claimed invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 2176

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam Sain whose telephone number is 571-272-4096. The examiner can normally be reached on M-F 9-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GS 6/10/06

GS


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